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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/819,669	03/17/1997	THIERRY BOON	LUD-5253.5-D	1995

24972 7590 12/27/2007
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EXAMINER	
GAMBEL, PHILLIP	

ART UNIT	PAPER NUMBER
1644	

MAIL DATE	DELIVERY MODE
12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 08/819,669	**Applicant(s)** BOON ET AL.	
	Examiner Phillip Gambel	**Art Unit** 1644	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11/16/07 11/19/07 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on *06 August 2007*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *183-191*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: See Continuation Sheet.

Phillip Gambel

PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
1600
12/12/07

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons of record.

With respect to the Request That Advisory Action Be Vacated and An Office Action Be Sent, filed 11/16/2007; the following is noted.

Once appellant / applicant files a notice of appeal in compliance with 37 CFR 41.31, the time period for reply set forth in the last Office Action is tolled and is no longer relevant for the time period for filing an appeal brief. See MPEP 1205.01.
Given that examiners must respond to all amendments filed after appeal has been taken and prior to termination of the appeal, An Advisory Action is deemed appropriate. See MPEP 1206.
By filing the Notice of Appeal, appellant / applicant has chosen post-appeal procedures.
Therefore, the request that the Advisory Action be vacated has been DENIED.

Appellant's / applicant's arguments in conjunction with certain legal decisions, filed 11/19/2007, have been fully considered but have not been found convincing essentially for the reasons of record.

In contradistinction to applicant's reliance upon Ex parte Kusco, 215 USPQ (BPAI 1981), which addressed the rejection under 35 USC 102(f) based upon a publication,
the evidence relied upon herein is U.S. Patent No. 5,843,448 ('448), including the claims of this patent.
U.S. patents are presumed valid by U.S. courts unless proven otherwise. See 35 U.S.C. 282.
Applicant appears to ignore the claims of U.S. Patent No. 5,843,448.

Furhther, in contrast to applicant's comments that the '448 patent contains an admission that MAGE-1 per se was known prior to the filing of the the application to the '448 patent,
it appears that Example 1 of the '448 is referrring to the source of MAGE-1 as well as Van der Bruggen et al., Science 254: 1643-1647 (December 13, 1991) paper for disclosure of the cloning of MAGE-1.
The '448 patent relies upon a series of continuations-in-part, with an earliest priority date of 05/23/1991 (USSN 07/705,702), the same as the instant application USSN 08/819,669.

While applicant relies upon the same nucleic acid and amino acid sequences between the instant applicant and U.S. Patent No. 5,342,774;
applicant appears to ignore that U.S.Patent No. 5,342,774 was subject to Relssue, because the sequences claimed in U.S. Patent No. 5,342,774 were in error.
Therefore, at the time U.S. Patent No. 5,843,448 and U.S. Patent No. 5,342,774 were initially allowed,
the sequences disclosed and/or claimed between the two were NOT necessarily the same, as implied by applicant.

The examiner will NOT comment on the non-precedential Ex parte Nishioka, 1995 WL (BPAI 1995).

As noted in the previous Advisory Action, mailed 10/23/2007,
Given applicant's Remarks concerning that:
"With respect to common ownership, a statement of such cannot be made, because
the ownership of U.S Patent No. 5,843,448 is joint, whereas the ownership of the current application resides with one party, Ludwig Institute for Cancer Research. The patent and application do not stand as prior art to each other, as each claims precisely the same priority";
the following is noted.

In accordance with MPEP 804,
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Here, the terminal disclaimer is not enforceable since the U.S. Patent and the instant application are not commonly owned.

Given that the U.S. Patent and the instant USSN are not commonly owned,
applicant should consider filing a Petition to Expunge according MPEP 724.05 in order to expunge the Terminal Disclaimer previously filed 12/12/2006.

Applicant has NOT responded to this issue presented in the previous Advisory Action.

The rejection under 35 USC 102(f) is maintained for the reasons of record.
See the previous Office Actions for a more complete analysis of the rejection under 35 USC 102(f).

Applicant may request an interview at their convenience.

With respect to

Continuation of 13. Other: An extension of time for three months under 37 C.F.R. 1.136(a) is required in order to enter and respond to the Request That Advisory Action Be Vacated and An Office Action Be Sent, filed 11/16/2007 and the Amendment, filed 11/19/2007.

This Request and Amendment have authorized the Director to charge Deposit Account No. 50-0624 under Order No. NY-LUD 5253-US5-DIV (09885911) the required fee of $1020 for this extension for which applicant's representative Norman Hanson is authorized to draw.